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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,990	12/31/2001	Ronald L. Edens	17,694	5317

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KIMBERLY-CLARK WORLDWIDE, INC.
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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,990

Applicant(s)

EDENS ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 7, 10, 18, 30 and 33 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because where is F, see page 13, lines 5-30? Where are 102 and 104, see page 17, lines 2-17? A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Description

3. The abstract of the disclosure is objected to because the abstract is too short, i.e. the length should be between 50 and 150 words in length. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: on page 1, line 2, "claims priority from" should be --claims the benefit of--. On page 2, lines 8 and 10, reference

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to the inventors should be avoided. The description should be limited to a factual description of the invention. On page 9, line 6, after "z-axis", --Z-Z-- should be inserted.

Appropriate correction is required.

5. The use of the trademark KOTEX(R)(page 10, lines 17 and 33 and page 11, line 17 and 32) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown either in all capital letters or with a trademark symbol but not both.

Claim Objections

6. Claims 1-34 are objected to because of the following informalities: in claims 1, 12, and 24, line 2, "the vestibule" should be --a vestibule--. Also, in claims 1, 12, 22, 24 and 33, should "areas"(all) and "area"(all) be --sides-- and --side--, respectively? Appropriate correction is required.

Claim Language Interpretation

7. It is noted that while "labial pad" is defined on page 4, lines 20-22 that the claims are drawn to an "absorbent article". "Vestibule" is defined as set forth on page 4, lines 24-31 and page 5, lines 4-6. "Disposition...vestibule" is defined as set forth on page 4, lines 31 et seq, and

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page 5, lines 10-15 and page 6, lines 1-5. The various directional terms used in the claims are defined as set forth on page 5, lines 16-31. "Notch" is defined as set forth on page 15, lines 1-2 and page 17, lines 25-26.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 12-16, 21-22 and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollard et al '212.

The Pollard device includes an absorbent article 20 comprising an absorbent, see col. 4, lines 23-25, which absorbent has axes, sides and end areas, see col. 5, lines 25-28 and 63-64, and at least one "notch", see definitions set forth supra and element or indentation G, i.e. a "notch", which extends inwardly from the periphery, see col. 7, lines 1-13. With regard to the functions, properties and capabilities set forth in claims 1, 12, and 24 i.e. "being configured...vestibule", and claims 3, 5, 14, 16, 26 and 28, see definitions above and note that the Pollard et al device includes the claimed structure. Therefore, there is sufficient factual basis for one to conclude that the functions, properties and capabilities of such claimed structure would also be inherent in the same structure of Pollard et al. See MPEP 2112.01. In any case, Applicant discloses the length of the claimed invention is less than or equal to 100 mm, the maximum width is less than or equal to 70 mm, the thickness is 0.5 to 10 mm and the notch having a width and depth no greater than 30mm. The Pollard et al disclosure at, e.g., col. 5, lines 60-66 disclose rectangles

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longest side and a height commensurate to those disclosed by Applicant. Also see the depth of G, i.e. element w and col. 10, lines 9-15, and the width of G, e.g. see col. 10, lines 16-31 and Figure 3F, i.e. the notch is triangular shaped and the width goes down to zero at the center, i.e. a width and a depth of the notch are no greater than 30 mm. Therefore, with regard to claims 1, 3-5, 12, 14-16, 24, 26-28, again there is sufficient factual evidence to conclude that the properties, functions and capabilities of such dimensions would also be inherent in the same dimensions of Pollard et al. See MPEP 2112.01. It is noted with regard to claims 4, 15 and 27, the claim does not require all the widths or the largest width being no greater than 30 mm.

10. Claims 1-6, 8-9, 11-17, 19-20, 22-29, 31-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Procter & Gamble, hereinafter called PG, '078.

The PG '078 reference teaches an absorbent article comprising an absorbent 20, having at least one notch, see Figure 1, in its periphery, and superabsorbent, see page 12, lines 17-18, a fluid permeable cover and a liquid impermeable baffle, see page 14, lines 2-4. The absorbent article appears to be configured for disposition within the vestibule as claimed in claims 1, 12 and 24, see definition supra and PG '078, i.e. definition of "interlabial absorbent structure" bridging pages 4-5 and the sentence bridging pages 5-6, and the dimensions appear to be sufficient to allow the spacing from the perineum and clitoris as claimed in claims 3, 5, 14, 16, 26 and 28, see '078 at portions cited immediately previous as well as Figure 1, last paragraph of page 11, first full paragraph on page 12 and page 16, second full paragraph. In any case, with regard to the functions, properties and capabilities set forth in claims 1, 12, and 24 i.e. "being configured...vestibule", and claims 3, 5, 14, 16, 26 and 28, see definitions above and note that the PG device includes the claimed structure. Therefore, there is sufficient factual basis for one

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to conclude that the functions, properties and capabilities of such claimed structure would also be inherent in the same structure of PG. See MPEP 2112.01. In still another or third case, Applicant discloses the length of the claimed invention is less than or equal to 100 mm, the maximum width is less than or equal to 70 mm, the thickness is 0.5 to 10 mm and the notch having a width and a depth no greater than 30mm. The PG reference discloses, at the portions cited above, lengths, widths and heights, i.e. calipers, commensurate to those disclosed by Applicant. Therefore, with regard to claims 1, 3-5, 12, 14-16, 24, 26-28, again there is sufficient factual evidence to conclude that the properties, functions and capabilities of such dimensions would also be inherent in the same dimensions of PG. See MPEP 2112.01. It is noted with regard to claims 4, 15 and 27, the claim does not require all the widths or the largest width being no greater than 30 mm.

11. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hershberger et al '544.

The Hershberger et al reference teaches an absorbent article comprising an absorbent 44, having at least one notch, see definitions set forth supra and indentation, i.e. a "notch" or the top portion of the S-shape, in the transverse end areas as seen in Figure 1 and the indentation, i.e. notch, formed by 94 in the longitudinal sides as seen in Figure 1B, which extends inwardly from the periphery, and superabsorbent, see col. 8, line 53, a fluid permeable cover, see Figure 7, element 46, col. 8, lines 61-64 and col. 10, lines 13-16, and a liquid impermeable baffle, see Figure 7, elements 24 and 28 and col. 12, lines 36-53. The absorbent article appears to be configured for disposition within the vestibule as claimed in claims 1, 12 and 24, see definition supra and definition of "interlabial" and "interlabial device" in col. 6, lines 16-44 and col. 7,

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lines 27-30, and the dimensions appear to be sufficient to allow the spacing from the perineum and clitoris as claimed in claims 3, 5, 14, 16, 26 and 28, see portions cited immediately previous as well as Figures, and col. 7, line 35-col. 8, line 2. In any case, with regard to the functions, properties and capabilities set forth in claims 1, 12, and 24 i.e. "being configured...vestibule", and claims 3, 5, 14, 16, 26 and 28, see definitions above and note that the Hershberger et al device includes the claimed structure. Therefore, there is sufficient factual basis for one to conclude that the functions, properties and capabilities of such claimed structure would also be inherent in the same structure of Hershberger et al. See MPEP 2112.01. In still another or third case, Applicant discloses the length of the claimed invention is less than or equal to 100 mm, the maximum width is less than or equal to 70 mm and the thickness is 0.5 to 10 mm. The Hershberger et al reference discloses, at the portions cited above, lengths, widths, i.e. calipers, and heights, commensurate to those disclosed by Applicant. The notches or indentations have the claimed dimensions, see again col. 7, line 35-col. 8, line 2, Figures 1 and 7, i.e. length of 94 as compared to 26 and col. 11, lines 7-21, i.e. the notch in the transverse end has a width equal to or less than the width y or height z, a depth equal to the length w of the upper portion subtracted from the length w of the lower portion, the notch in the longitudinal side has a depth equal to or less than the width y or caliper z and a width less than the length w of the upper portion. Therefore, with regard to claims 1, 3-5, 12, 14-16, 24, 26-28, again there is sufficient factual evidence to conclude that the properties, functions and capabilities of such dimensions would also be inherent in the same dimensions of Hershberger et al. See MPEP 2112.01. It is noted with regard to claims 4, 15 and 27, the claim does not require all the widths or the largest width being no greater than 30 mm.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over PG '078 in view of PG '075.

Applicants claim the cover encloses the absorbent while PG '078 teaches a topsheet and backsheet on opposite sides of the absorbent. See page 14, first full paragraph and page 16, lines 1-2. However, PG '075 at page 15, fourth full paragraph teaches the interchangeability of such a configuration in which there is a topsheet on the body facing surface and a backsheet on the opposite surface and a configuration in which the topsheet at least partially wraps the labial device absorbent, i.e. can enclose the absorbent. Therefore, to make the topsheet and backsheet on opposite sides of the absorbent of PG '078 a topsheet which encloses the absorbent instead

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would be obvious to one of ordinary skill in art in view of the interchangeability as taught by PG '075.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 1-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/036,635 in view of PG '609. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application and the other application were filed on the same day, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the claims of the other application? The answer is yes. The claims of the '635 application include all the structure claimed in the instant application except for axes, and a periphery defined by longitudinal sides and transverse end areas. The '635 application claims a generally circular geometry and periphery. See PG '609 at page 16, lines 13-19, i.e. a circular geometry and periphery is exchangeable for a geometry and periphery defined by longitudinal sides and transverse end areas and axes, e.g. a rectangle, a

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trapezoid. To make the circular geometry and periphery of '635 a periphery defined by longitudinal sides and transverse end areas and instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by PG '609.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

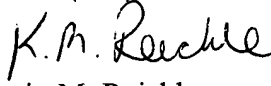
Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The McCoy and Van Tilberg references show various shaped side panels. The Hirschman, PG '077 and Sartorio references cited by Applicant also teach many of the claimed features. The Sneider reference cited by Applicant shows an absorbent article with notches.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR